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Manabu Hayashi

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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

STOREY, WILLIAM C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/658,778 | Applicant(s) HAYASHI ET AL. | |
| | Examiner WILLIAM C. STOREY | Art Unit 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/5/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 25 (and its dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims "a selection unit that selects a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the first determining unit determines that the facsimile-forwarding is instructed and selects a facsimile-forwarding destination corresponding to the senders registered by the registering unit when the second determining unit determines that the sender of the email is within the senders registered by the registering unit." However, this wording is contentious. In the specification, it talks of how if a destination is both instructed by email and is registered, the instruction of the email will reign (pg. 12, lines 22-24); or, talks of how the email instructed destination address must be registered to the sender. However, the wording of this limitation runs

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counter to the specification. It is possible that a sender be both registered and instructed by email the destination. In addition, it does not disclose in the specification submitted at the time of filing, a destination being selected solely by checking whether the sender of the message is registered or not. For the purposes of the following discussion of the claim, the examiner will assume the applicant to mean a selection unit that selects a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the first determining unit determines that the facsimile-forwarding is instructed by email and selects a facsimile-forwarding destination corresponding to the senders registered by the registering unit when the second determining unit determines that the sender of the email is within the senders registered by the registering unit, there is a referral to a corresponding destination, and the first determining unit determines that the facsimile-forwarding is not instructed by email without a corresponding stored destination.

4. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 26 claims "the reporting unit saves the facsimile-forwarding data converted by the converting unit and sends a report reporting that the facsimile-forwarding data was saved by an email to the sender of the email." However, the specification provided as of the original filing date contains no mention of saving and then sending an email reporting the saving to the sender of the email when

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there is a transmission failure. The specification talks of faxing an "accumulation" report to the facsimile destination (pg. 13, lines 11-16). For the purpose of the following discussion of the claim, the examiner will assume the applicant to mean sending a facsimile to the facsimile destination, as talked about above, instead of sending an email to the sender of the email.

5. Claim 18 (and its dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant remarked during the most recent interview that a number of pages as a limit would not correspond to forwarding size upper limit due to the word "size." In addition, the specification presents the forwarding size upper limit as separate from the forwarding page upper limit and provides no other support for the forwarding size upper limit being based on a number of pages.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 13 (and its dependents) is rejected 35 U.S.C. 112. Claim 13 recites the limitation "the apparatus." However, no prior apparatus has been defined. It is unclear whether the apparatus is to refer to a facsimile machine, or if a mistake was made in the writing of the claim. There is insufficient antecedent basis for this limitation in the claim. The examiner will assume the applicant to mean that "the apparatus" refer to "an image

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communication apparatus," which replaces the phrase "an image communication" at the beginning of the claim.

8. Claim 25 (and its dependents) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "Instructed" is referred to numerous times in the claim. However, it is unclear as if "instructed" is to always refer to the previously-mentioned "facsimile-forwarding is instructed by the email." Please clarify. For the purposes of consideration, the examiner will assume that reference to "instructed" are to refer to the similar "instructed by email" reference in the claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 13-17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld et al. (US 5859967), hereinafter referred to as Kaufeld, in view of Eguchi (US 6982803) and Miyanaga (US 7009725).

Regarding claim 13, the claim reads an image communication apparatus for sending a facsimile data to a facsimile machine, the apparatus comprising (the system of Kaufeld is disclosed as capable of sending a facsimile to a facsimile machine (Kaufeld: col. 3, lines 35-42)):

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an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.); an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing); a determining unit that determines whether facsimile-forwarding is instructed by the email analyzed by the analyzing unit (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the determining unit in the process in order to glean the fax number.);

a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, if the determining unit determines that the facsimile-forwarding is instructed (As has been discussed above and at column 3, lines 38-42, the transmission computer, reading on claimed converting unit, converts the email into a fax and sends the email to the fax number instructed in the email. Facsimile data in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission.);

a setting unit that sets an upper limit for facsimile-forwarding the email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

and a forwarding control unit that conducts facsimile-forwarding of the facsimile data converted by the converting unit to a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the facsimile data converted by the converting unit does not exceed the upper limit set by the setting unit (The transmission computer performs the above and thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation.)

However, Kaufeld fails to disclose an upper limit for transmission being a forwarding size limit of facsimile data.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a

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forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4.

Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines 6-67)). Based on whether the limit is exceeded, the fax is allowed to proceed or not. Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi.

However, Eguchi has taught a receiving side checking the initial size of data to be sent. Though the data may be in email format, the system still shows how the data size is able to be compared for fax storage. However, Eguchi did not distinctly show the sending side checking. Though this would be an obvious connection to have a similar process run by the sending side rather than the receiving side accordingly, the examiner provides a reference that shows the idea of a sending side checking, in order to provide further support.

In a similar field of endeavor, Miyanaga discloses a communication control method and system. Miyanaga discloses at col. 1, lines 63-67, col. 2, lines 1-3 that it is determined whether the transmission data amount of image data to be sent to a server

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from a communication apparatus exceeds the limit capacity of the server before the image data is sent, and that processing (limiting) is performed when the image data exceeds the limit capacity of the server. Though Miyanaga discloses the scenario with respect to email, the difference with respect to transmission of facsimile data would be insubstantial. In addition, the image data that is checked is the image data from a converted facsimile (col. 3, lines 31-34). The idea of checking reception capacity before transmission could be applied. It would have been obvious to modify the current system by allowing for Kaufeld to check fax server capacity for limiting (Eguchi), but to check before sending (Miyanaga) in order to save a lot of time for the image transmission (col. 1, lines 61-62) that might occur if the data is sent, but not able to be fully received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing the upper limit being a forwarding size limit of facsimile data, as taught by Eguchi and Miyanaga, for the purpose of saving time.

Regarding claim 14, the previous disclosures disclose everything applied above for claim 13. In addition, Kaufeld discloses a forward stopping control unit that stops facsimile-forwarding of the facsimile data converted by the converting unit when the facsimile data converted by the converting unit exceeds the forwarding size upper limit (It was disclosed above how the fax transmission attempts are ceased, which reads on claimed stops facsimile forwarding; once the counter exceeds the predetermined value. Similar limiting may be applied if the data size exceeds a storage capacity (forwarding size upper limit), as previously mentioned with regard to the last claim, in order to

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prevent errors and free up the system resources (such as transmission availability) for other processes or transmissions that may be completed. Transmission computer reads on claimed forward stopping control unit for reasons disclosed above.); and a reporting unit that sends a report of facsimile-forwarding failure by an email to a sender of the email when the facsimile-forwarding of the facsimile-forwarding data was stopped by the forward stopping control unit (Column 9, lines 9-20, fig. 8c, disclose that once no further attempts at fax transmission are to be made, an email is sent back to the sender indicating that the facsimile transmission was not successfully transmitted. In addition, details as to why are included. All of this reads on claimed report of facsimile-forwarding failure. Transmission computer reads on claimed reporting unit for reasons disclosed above.)

Regarding claim 15, the previous disclosures disclose everything applied above for claim 13. However, the previous disclosures did not distinctly disclose a splitting unit that splits facsimile data into a plurality of the facsimile data; and a split forwarding unit that forwards the plurality of the facsimile data split by the splitting unit to the facsimile destination one after another.

Miyanaga discloses that when the transmission data amount exceeds the capacity (forwarding size upper limit), that the image data to be sent is divided (split) and each divided part is sent one by one so that the amount of data for a single transmission is reduced (col. 9, lines 32-38).

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In addition, limiting taught by Eguchi, who taught limiting by capacity, allows for division of fax data, in order to allow for the whole fax to be sent while still working within the confines of the capacity limit (Eguchi, col. 5, lines 50-55).

The splitting and forwarding may be done when a limit is exceeded, like a capacity limit (forwarding size upper limit), so that a disconnection or some other error might be able to be avoided and better success afforded. Kaufeld previously taught converting. Kaufeld previously taught facsimile-forwarding. Facsimile-forwarded data is facsimile data. The systems of Eguchi and/or Miyanaga that provide for the splitting and sending of the data in conjunction with the previous disclosures, such as of Kaufeld, may read upon claimed splitting unit and split forwarding unit.

Regarding claim 17, the claim is rejected based upon similar reasoning as applied above for claim 13.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 13 above, and further in view of Misawa et al. (US 6771382), hereinafter referred to as Misawa; and Matsumoto et al. (US 6373598), hereinafter referred to as Matsumoto.

Regarding claim 16, Kaufeld discloses everything as applied above for claim 13. For the purposes of the claim, the forwarding size upper limit will be redefined for claim 16. It has previously been discussed how the size of a fax to be transmitted may be compared against a reference value (such as the amount of available storage for Eguchi.) However as has not been previously discussed, Misawa points out that communications over a network (such as to send a fax to a relay device 34 in Kaufeld)

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are subject to limitations in that the amount of information (information capacity) to be processed in a unit time is limited to a certain value (col. 1, lines 50-53). Misawa goes on to explain at col. 4, lines 59-67 that certain times of day correspond to different information capacity limitations. Thus, as size comparison to a reference has been taught, and as Kaufeld has taught waiting a predetermined period of time to resend (col. 9, lines 4-9), it would have been obvious to consider the information capacity limitation against the data size, and if the data size exceeded the information capacity (forwarding size upper limit), to resend at a later time when the information capacity might increase. This provides for greater system flexibility, robustness, and success. In addition, Kaufeld disclosed that if an attempt to send fails and that the transmit counter has not exceeded the predetermined value, the system waits a predetermined period of time in order to attempt to send the fax again (column 9, lines 4-9). However, as the time limit acts a remedy to initial failures to send, it would have been obvious to one of ordinary skill in the art at the time the invention was made to wait the predetermined period of time for the purpose of using the wait time as the solution to the size limit being exceeded, and allow a chance for a greater capacity to be available in order to see if delaying the transmission will solve the problem. This provides for greater system simplicity. Further, though Kaufeld discloses that the predetermined amount of time could be 5 to 10 minutes, it would of course be obvious to set to a different amount of time for the purpose of providing greater system flexibility. However, Matsumoto discloses being able to schedule facsimile transmission at a specific time or after a certain period of time has passed (col. 1, lines 23-27, col. 1, lines 48-53). Thus, the

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time may be programmed so that a different delay that would correspond with a time of higher information capacity may be set. This would provide for greater system flexibility, robustness, convenience, and success. The transmission computer of Kaufeld/fax machine mentioned by Matsumoto may read on claimed specifying unit and time-specified forwarding control unit. If the facsimile data is not forwarded until a specific time when the limit has been exceeded; inherently, the facsimile-forwarding has been suspended until the time specified.

12. Claims 18-25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 13 above, and further in view of Okutomi et al. (US 6211972), hereinafter referred to as Okutomi.

Regarding claim 18, the claim inherits everything as applied above for claim 13. However, the previous disclosures fail to disclose limiting by number of pages. However, the examiner maintains that it was well known in the art to provide limiting by number of pages, as taught by Okutomi.

In a similar field of endeavor, Okutomi discloses an electronic mail converting apparatus for facsimile. In addition, Okutomi discloses a LAN controlling section that compares the number of fax sheets to be produced from an email with the maximum output number of sheets, as disclosed at column 6, lines 48-51 and 61-66. The maximum number of sheets the fax machine has to output reads on forwarding size upper limit based on a number of pages. The number of pages that would be transmitted corresponds to image data and thus, data size. If the maximum output

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number of sheets is less than the number of email pages, then the transmission is limited, as disclosed in column 6, lines 66-67 and column 7, lines 1-4 and 14-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing limiting by number of pages, as taught by Okutomi, for the purpose of saving cost, as disclosed in column 7, lines 21-23.

Regarding claim 19, the claim reads an image communication apparatus for sending a facsimile data to a facsimile machine, the apparatus comprising (the system of Kaufeld is disclosed as capable of sending a facsimile to a facsimile machine (Kaufeld: col. 3, lines 35-42)):

an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.); an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing); a registering unit that registers senders whose emails are permitted to be facsimile-forwarded and facsimile-forwarding destinations (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.); a determining unit that

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determines whether a sender of the email analyzed by the analyzing unit is registered by the registering unit (Transmission computer reads on claimed determining unit. It was disclosed above how the email address of the sender is checked to be valid, and acted upon accordingly (fig. 8a));

a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile machine, when the sender of the email is registered by the registering unit (column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Fig. 8a-8b show that in order for the email to be converted to fax, the email sender must have a valid account. Transmission computer reads on claimed converting unit. Facsimile data in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission.);

a setting unit that sets an upper limit for facsimile-forwarding the email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

and a forwarding control unit that conducts facsimile-forwarding of the facsimile data converted by the converting unit to a facsimile-forwarding destination registered by the registering unit when the facsimile data converted by the converting unit does not exceed the upper limit set by the setting unit (The transmission computer performs the

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above and thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation. It was disclosed above how the user may register destination addresses for receipt of a facsimile transmission.)

The examiner maintains that it was well known in the art to provide corresponding the destinations to the senders, as taught by Okutomi.

Okutomi discloses corresponding the destinations to the senders (column 3, lines 28-30, fig. 6 disclose storing a correspondence table of e-mail addresses and telephone numbers. Column 6, lines 6-12 goes further to include extracting the sender's address, corresponding it to an address book and transmitting it to a corresponding telephone number for receiving a facsimile transmission. Column 5 lines 54-61 also includes the ability to correspond a list of address as an address book. It would be obvious to correspond multiple addresses to a sender in the same way as for one for the purpose of consolidation.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing corresponding the destinations to the senders, as taught by Okutomi, for the purpose of not allowing other senders "open directory access" to destination addresses that a particular sender has registered.

In addition, Kaufeld fails to disclose an upper limit for transmission being a forwarding size limit of facsimile data.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines 6-67)). Based on whether the limit is exceeded, the fax is allowed to proceed or not. Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi.

However, Eguchi has taught a receiving side checking the initial size of data to be sent. Though the data may be in email format, the system still shows how the data

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size is able to be compared for fax storage. However, Eguchi did not distinctly show the sending side checking. Though this would be an obvious connection to have a similar process run by the sending side rather than the receiving side accordingly, the examiner provides a reference that shows the idea of a sending side checking, in order to provide further support.

In a similar field of endeavor, Miyanaga discloses a communication control method and system. Miyanaga discloses at col. 1, lines 63-67, col. 2, lines 1-3 that it is determined whether the transmission data amount of image data to be sent to a server from a communication apparatus exceeds the limit capacity of the server before the image data is sent, and that processing (limiting) is performed when the image data exceeds the limit capacity of the server. Though Miyanaga discloses the scenario with respect to email, the difference with respect to transmission of facsimile data would be insubstantial. In addition, the image data that is checked is the image data from a converted facsimile (col. 3, lines 31-34). The idea of checking reception capacity before transmission could be applied. It would have been obvious to modify the current system by allowing for Kaufeld to check fax server capacity for limiting (Eguchi), but to check before sending (Miyanaga) in order to save a lot of time for the image transmission (col. 1, lines 61-62) that might occur if the data is sent, but not able to be fully received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing the upper limit being a forwarding size limit of facsimile data, as taught by Eguchi and Miyanaga, for the purpose of saving time.

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Regarding claim 20, this claim inherits everything as applied above from claim 19 (col. 7, lines 46-50. As the sender sends from an email address, it would at least have been obvious to send the message back to the user by way of email for the purpose of convenience.) In addition, claim 20 is rejected based upon similar reasoning as applied above for claim 14.

Regarding claim 21, this claim inherits everything as applied above from claim 19. In addition, claim 21 is rejected based upon similar reasoning as applied above for claim 15.

Regarding claim 22, this claim inherits everything as applied above from claim 19. In addition, claim 22 is rejected based upon similar reasoning as applied above for claim 16. Data amount of facsimile data is covered by the scope of claim 16.

Regarding claim 23, this claim inherits everything as applied above from claim 19. In addition, claim 23 is rejected based upon similar reasoning as applied above for claim 17.

Regarding claim 24, this claim inherits everything as applied above from claim 19. In addition, claim 24 is rejected based upon similar reasoning as applied above for claim 18.

Regarding claim 25, Kaufeld discloses an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.); an analyzing unit that analyzes the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, reads on claimed analyzing); a registering unit that

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registers senders whose emails are permitted to be facsimile-forwarded and facsimile-forwarding destinations (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list.); a first determining unit that determines whether facsimile-forwarding is instructed by the email analyzed by the analyzing unit (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the determining unit in the process in order to glean the fax number.); a second determining unit that determines whether a sender of the email analyzed by the analyzing unit is registered by the registering unit (Transmission computer reads on claimed determining unit. It was disclosed above how the email address of the sender is checked to be valid, and acted upon accordingly (fig. 8a)); a converting unit that converts the email into the facsimile data, the facsimile data including an image data to be transferred to the facsimile

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machine, if the determining unit determines that the facsimile-forwarding is instructed (column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Previously disclosed, column 3, lines 38-42, the transmission computer, reading on claimed converting unit, converts the email into a fax and sends the email to the fax number instructed in the email. Facsimile data in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission. Transmission computer reads on claimed converting unit.)

a setting unit that sets an upper limit for conducting facsimile-forwarding email (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

The examiner maintains that it was well known in the art to provide corresponding the destinations to the senders and, as taught by Okutomi.

Okutomi discloses corresponding the destinations to the senders (column 3, lines 28-30, fig. 6 disclose storing a correspondence table of e-mail addresses and telephone numbers. Column 6, lines 6-12 goes further to include extracting the sender's address, corresponding it to an address book and transmitting it to a corresponding telephone number for receiving a facsimile transmission. Column 5 lines 54-61 also includes the

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ability to correspond a list of address as an address book. It would be obvious to correspond multiple addresses to a sender in the same way as for one for the purpose of consolidation.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing corresponding the destinations to the senders, as taught by Okutomi, for the purpose of not allowing other senders "open directory access" to destination addresses that a particular sender has registered.

Kaufeld and the disclosure of Okutomi disclose a selection unit that selects a facsimile-forwarding destination specified by the facsimile-forwarding instruction when the first determining unit determines that the facsimile-forwarding is instructed (Kaufeld discloses that the user may specify a destination without a referral to a stored destination by email, as disclosed above by specifying a specific fax number in the to address of the email.) and selects a facsimile-forwarding destination corresponding to the senders registered by the registering unit when the second determining unit determines that the sender of the email is within the senders registered by the registering unit (It was also disclosed above (and at column 10, lines 54-60 and column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Fig. 8a-8b show that in order for the email to be converted to fax, the email sender must have a valid account) how the user may alternatively refer to a stored (registered) destination or destination list by name. It was disclosed above by

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Okutomi how a sender's address is checked for registration and then sent to an associated facsimile destination. The transmission computer reads on claimed selection unit, as it performs the processes of receiving, processing and transmitting the email/facsimiles as has been discussed previously.) (Please note the discussion under the claim rejections section above.); and a forwarding control unit that conducts facsimile-forwarding of the facsimile data converted by the converting unit to a facsimile-forwarding destination selected by the selection unit when the facsimile data converted by the converting unit does not exceed the upper limit set by the setting unit ((The transmission computer performs the above and thus, reads on claimed forwarding control unit. Fig. 8c shows the attempt of fax transmission for the process described previously. Fig. 8c shows the fax transmission allowed to proceed if the counter is below the predetermined number, which reads on claimed does not exceed the upper limit. This and the previous disclosures read on preceding limitation. It was disclosed above how the user may register destination addresses for receipt of a facsimile transmission. The discussion of transmission allotted by the selection unit is also disclosed above.).

In addition, Kaufeld fails to disclose an upper limit for transmission being a forwarding size limit of facsimile data.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for

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greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4.

Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines 6-67)). Based on whether the limit is exceeded, the fax is allowed to proceed or not. Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi.

However, Eguchi has taught a receiving side checking the initial size of data to be sent. Though the data may be in email format, the system still shows how the data size is able to be compared for fax storage. However, Eguchi did not distinctly show the sending side checking. Though this would be an obvious connection to have a similar process run by the sending side rather than the receiving side accordingly, the examiner provides a reference that shows the idea of a sending side checking, in order to provide further support.

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In a similar field of endeavor, Miyanaga discloses a communication control method and system. Miyanaga discloses at col. 1, lines 63-67, col. 2, lines 1-3 that it is determined whether the transmission data amount of image data to be sent to a server from a communication apparatus exceeds the limit capacity of the server before the image data is sent, and that processing (limiting) is performed when the image data exceeds the limit capacity of the server. Though Miyanaga discloses the scenario with respect to email, the difference with respect to transmission of facsimile data would be insubstantial. In addition, the image data that is checked is the image data from a converted facsimile (col. 3, lines 31-34). The idea of checking reception capacity before transmission could be applied. It would have been obvious to modify the current system by allowing for Kaufeld to check fax server capacity for limiting (Eguchi), but to check before sending (Miyanaga) in order to save a lot of time for the image transmission (col. 1, lines 61-62) that might occur if the data is sent, but not able to be fully received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing the upper limit being a forwarding size limit of facsimile data, as taught by Eguchi and Miyanaga, for the purpose of saving time.

13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 25 above, and further in view of Ray (US 2004/0128207).

Regarding claim 26, the previous disclosures disclose everything as applied above for claim 25. In addition, Kaufeld and the previous disclosure of Okutomi

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disclose a third determining unit that determines whether or not the facsimile-forwarding by the forwarding control unit was successful (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. Thus, when the transmit counter limit has been exceeded the system knows that the transmission has been unsuccessful. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed third determining unit.); a fourth determining unit that determines whether the facsimile-forwarding destination selected by the selection unit is at least one of the destination specified by the facsimile-forwarding instruction and the destination corresponding to the senders registered by the registering unit (It has been disclosed previously how Kaufeld discloses being able to extract a specific destination address from an email, which reads on claimed destination specified by the facsimile-forwarding instruction; and how Kaufeld shows referencing a stored destination through a name or name list that is corresponded as taught by Okutomi, which reads on claimed destination corresponding to senders registered by the registering unit. Therefore, Kaufeld discloses the two options working alternatively, and the system being able to determine when a name is referring to a registered address(es), which reads on claimed determines. The transmission computer performs the functions of converting, transmitting, etc. as discussed previously and thus, reads on claimed fourth determining unit.); and a reporting unit that sends a report of facsimile-forwarding failure by an email to the sender of the email when the third determining unit determines that the facsimile-

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forwarding was not successful and the fourth determining unit determines that the facsimile-forwarding destination selected by the selection unit is specified by the facsimile-forwarding instruction (column 9, lines 9-20 disclose sending an email back to the sender reporting that the facsimile transmission was unsuccessful and details as to why. Fig. 4, column 7, lines 43-44 disclose that the figs. 8a-8c, in which the previous disclosure is contained, are run through for an example of figure 4, where the instruction is set in the to line of the email, which reads on claimed facsimile-forwarding destination specified by the facsimile-forwarding instruction. Because of the "or" between the two limitations, this reads on the preceding and following limitations based on the location in the claim. Transmission computer reads on claimed reporting unit.),

However, the previous disclosures fail to disclose deleting the forwarding data when there is a transmission failure. However, the examiner maintains that it was well known in the art to provide deleting the forwarding data when there is a transmission failure, as taught by Eguchi.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. In addition, Eguchi discloses deleting the forwarding data when there is a transmission failure (Eguchi discloses a size limit for forwarding of an email. If the email size is too big, the user may select not to receive the item, to return a message to the sender, or forward it to a destination. If the setting is on return or forward, the memory where the message is received is cleared and the email is deleted from the electronic mail box (column 5, lines 11-41, 18-22, 32-34, & 39-40).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing deleting the forwarding data when there is a transmission failure, as taught by Eguchi, for the purpose of freeing up space in order to allow more messages to come in that might be able to be transmitted.

Kaufeld has taught previously converting email data to facsimile data by the time that the transmission is found to be unsuccessful. Therefore, the combination would read on claimed deletes the facsimile-forwarding data converted by the converting unit.

In addition, the previous disclosures fail to disclose saving an item for transmission and sending a facsimile report that it was saved (an accumulation report) to a destination. However, the examiner maintains that it was well known in the art to provide saving an item for transmission and sending a report that it was saved to a destination, as taught by Ray.

In a similar field of endeavor, Ray discloses systems and methods for providing item delivery notification. In addition, Ray discloses saving an item for transmission and sending a facsimile report that it was saved to a destination (Ray discloses a system for notifying recipients and/or senders about the transmission process of a package, for example. Ray discloses sending a notification, which reads on claimed; reporting that an item was not deliverable (as in the package was too big for the mailbox) and that it is being saved for the recipient available to be picked up at a central location, like a post office (§ 36, § 38), which reads on saving the item that is trying to be transmitted and sending a report that it was saved to a destination. In addition, Ray discloses

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communication with the recipient over a communications system, like the internet (§ 23, 24). The communication to notify the recipient may take place by email or by facsimile, for example (§ 24), by a facsimile to a facsimile destination.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing saving an item for transmission and sending a facsimile report that it was saved to a destination, as taught by Ray, for the purpose of allowing a recipient to know the transmission status of their facsimile delivery and providing more overall system (including the receiver, in this case) awareness.

Kaufeld has taught previously converting email data to facsimile data by the time that the transmission is found to be unsuccessful. Therefore, the combination would read on claimed saves the facsimile data converted by the converting unit.

Response to Arguments

14. Applicant's arguments filed 6/23/08 have been fully considered but they are not persuasive.

Regarding the discussion for claim 25 (and dependents), the substance of the applicant's proposal regarding the claim(s) surrounds the idea that fig. 5 provides for the deficiencies mentioned previously in the 112 rejection of claim 25. However, the blanket reference to fig. 5 does not make apparent how the specification provided for the deficiencies previously mentioned. Fig. 5 discloses that if the sender is not registered, that the forwarding is not permitted, and the email is printed out. This is in contrast with the fact that a facsimile-forwarding destination will be selected if the

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sender is registered and selects a facsimile-forwarding destination specified by instruction when it is determined that the facsimile forwarding is instructed (by email.)

Regarding the discussion for the 112 rejection of claim 26 (and dependents), the substance of the applicant's proposal regarding the claim(s) surrounds the idea that Fig. 7 provides support. However, the amendment nor figure 7 gets around the fact that no support for an accumulation report being sent to the sender of the email was provided. As mentioned, the accumulation report was sent to the facsimile destination, not the sender of the email. Fig. 7 says only that an unforwarding report is returned to the sender of an email. However, with regard to a stored, or saved, document, fig. 7 forwards an accumulation report. Pg. 13, lines 11-16, with reference to step s505 in fig. 7 support that the accumulation report is sent to the forwarding destination, not the sender of an email.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/William C Storey/
Examiner, Art Unit 2625

William C Storey
Examiner
Art Unit 2625

/W. C. S./
Examiner, Art Unit 2625
/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625